UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 24

Application Number: 09/557,804
Filing Date: April 25, 2000
Appellant(s): HARDING ET AL.

Jay P. Lessler
For Appellant

EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed May 23, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because Appellant indicates a novel carboxymethyl cellulose (CMC) having significantly higher viscosities than similar CMC produced by prior art methods, which is part of the argument.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 39 and 60-63 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 39 and 60-63 are rejected under 35 U.S.C. 102(a) as being anticipated by Mansikkamaki et al (EP 0879827).

Appellants claim a carboxymethyl cellulose ether prepared by a method comprising the steps of: (a) obtaining mercerized and recovered cellulose pulp; and (b) converting the mercerized and recovered cellulose pulp into carboxymethyl cellulose, wherein the mercerized cellulose pulp in step (a) was mercerized with a cellulose II mercerizing agent, and the mercerized and recovered cellulose pulp has a TAPPI 230 om-89 viscosity greater than 12 cP, when the cellulose pulp is southern softwood kraft. Additional independent claims are drawn to the carboxymethyl cellulose ether product with additional process steps. Additional limitations in the dependent claims include the cellulose pulp being a sulfite cellulose pulp and further process steps for preparing the carboxymethyl cellulose ether.

The Mansikkamaki et al patent discloses carboxymethyl cellulose derived from sulphite softwood pulp (see page 2, line 14), which is analogous to the softwood kraft cellulose pulp used in the preparation of instant Claims 39 and 60-64. Mansikkamaki et al also shows that mercerization of cellulose pulp during preparation of carboxymethyl cellulose is known in the art (see page 2, lines 18-21). The Mansikkamaki et al patent sets forth, in Table 2 on page 3 of the document, viscosity values for the carboxymethyl cellulose thereof that anticipates the viscosity values disclosed in the instant claims. The carboxymethyl cellulose ether of the instant claims differs from the carboxymethyl cellulose of the Mansikkamaki et al patent by setting forth the instant claims in product-by-process forms. However, process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc.* v. *United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Appellant is further reminded that the Office is in no position to determine

experimentally whether of not, in an invention such as that at issue, the subject matter is the same as that of the reference – in regard to using 2% aqueous solution to measure the viscosity of the carboxymethyl cellulose in the Mansikkamaki et al patent as opposed to using a 1% aqueous solution that is set forth in the instant claims. Accordingly, in such instances, this shifts the burden to the Appellant who has the resources to make such a determination and is in a better position to determine experimentally the differences between the invention as claimed and that of the art. *In re Pye*, 355 F2d 641, 148 USPQ 426 (CCPA 1966). The instantly claimed carboxymethyl cellulose ether product, per se, does not set forth characteristics that make the product different and patentable over the carboxymethyl cellulose ether product of the Mansikkamaki et al patent. Accordingly, the carboxymethyl cellulose ether disclosed in the Mansikkamaki et al patent anticipates the carboxymethyl cellulose ether of the instant claims.

(11) Response to Argument

Appellant's arguments filed in the Appeal Brief dated January 15, 2003 and in the Supplemental Appeal Brief dated March 23, 2003 have been fully considered but they are not persuasive. Appellant argues against the rejection on the ground that the instantly claimed carboxymethyl cellulose (CMC) is somehow different because of the process used to produce the product. This argument is not persuasive since process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc.* v. *United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. The office considers product-by-process claims as product claims. Even if one could give some consideration to the limitation of the process, one of ordinary skill in the art would not obtain a different carboxymethyl cellulose product than that which is set forth in the Manskkamaki et al patent since the procedures thereof are within the scope of the

instantly claimed process. The Manskkamaki et al patent discloses procedures that involve mercerization, etherification, and neutralization of the reactants to produce a carboxymethyl cellulose product, wherein the process steps of the Manskkamaki et al patent are within the scope of the mercerization, etherification, and neutralization steps set forth in the instant product-by-process claims. Even the starting material set forth in the Manskkamaki et al patent is analogous to the starting material set forth in the instant claims. For example, see page 2, line 14 of the Manskkamaki et al patent wherein the CMC is prepared from a sulphite softwood pulp, which anticipate the sulfite cellulose pulp set forth in instant Claim 62. See page 2, line 15 of the Manskkamaki et al patent wherein the CMC may be prepared from cotton linter, which anticipates the cotton linter set forth in instant Claim 63. Hence, arguments presented by Appellant regarding the pulp of the instant invention being of a different type and having a different viscosity is not persuasive since products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Appellant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. One having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product because the skilled artisan would have expected the analogous starting materials to react similarly. Finally, the Board attention is directed to Table 2 on page 3 of the Manskkamaki et al patent wherein the viscosities of the carboxymethyl cellulose for the products of Example 1 are set forth to be 1400 mPas and 1600 mPas, which anticipates the viscosity values of the carboxymethyl cellulose ethers set forth section (ii) and section (iii) of instant Claim 63. Accordingly, the rejection of Claims 39 and 60-63 under 35 U.S.C. 102(a) as being anticipated by the Mansikkamaki et al patent should be affirmed for the reasons of record.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James O. Wilson
Supervisory Primary Examiner
Technology Center 1600
March 1, 2004

March 1, 2004

Conferees

Samuel Barts, Ph.D.
Primary Examiner
Technology Center 1600

Supervisory Patent Examiner
Technology Center 1600

Darby & Darby PC
805 Third Avenue
New York, NY 10022

LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

EW